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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

WOO, S

ART UNIT

PAPER NUMBER

2743

12

DATE MAILED:

08/25/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/134,831

Applicant(s)
Mettke

Examiner
Stella Woo

Group Art Unit
2743



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-9 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-9 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8, 11

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. A protest against issuance of a patent based upon this application was filed under 37 CFR 1.291(a) on November 4, 1998 by TouchNet Information Systems, Inc., and a copy has been served on applicant.

A protest against issuance of a patent based upon this application was filed under 37 CFR 1.291(a) on March 31, 1999 by North Communication, Inc. However, this protest did not include a copy of every document relied upon by the protestor, as required by 37 CFR 1.291(b)(3). A supplemental protest was filed April 1, 1999 providing the missing prior art documents. A complete protest, which duplicates the initial protest papers filed March 31, 1999 and the supplemental papers filed April 1, 1999, was filed April 1, 1999 under 37 CFR 1.291(a), and a copy has been served on applicant.

A protest against issuance of a patent based upon this application was filed under 37 CFR 1.291(a) on August 17, 1999 by Griffes Consulting, SA, and a copy has been served on applicant.

The three protests filed November 4, 1998, April 1, 1999, and August 17, 1999 have been considered by the Office as discussed below.

2. Protest filed November 4, 1998 under 37 CFR 1.291(a) by TouchNet Information Systems, Inc.

A. Protestor asserts that the Protestor was the first to invent the subject matter taught and claimed in the original patent.

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There is insufficient evidence to support the allegation. The exhibits presented fail to show that the Protestor was the *first* to invent the subject matter of the original patent (claims 1-5 of the present reissue application). Exhibit A shows the disclosure of a U.S. patent application S.N. 07/600,712 which was abandoned. Since this application did not successfully result in a patent, it is not clear how this demonstrates the Protestor as being the first to invent. The Office actions issued during the prosecution of S.N. 07/600,712 (Exhibit I) provide clear reasons why the Protestor was not the first to invent, including the citation of the prior art reference of U.S. Patent No. 4,359,631 to Lockwood et al. (Exhibit H).

B. Protestor asserts that the Protestor was the first to invent the subject matter taught and claimed in the reissue application.

Again, a U.S. patent was not granted for the subject matter disclosed by the Protestor such that it has not been established that the Protestor was the *first* to invent the subject matter of claims 1-5 of the reissue application. Claims 6-9 of the reissue application recite accessing and interfacing with the Internet. Although Exhibit C,4 shows a frame from the video tape of Exhibit C advertising connection to the Internet, it was stated in the deposition of Daniel J. Toughey (Exhibit K, page 44, lines 10-23) that the terminal shown in the video tape did not actually enable a user to gain access to the Internet. None of the other documents show that the Protestor invented a public, on-line, pay-as-you-use communications terminal as recited in claims 6-9 of the reissue application, specifically, "means for accessing the Internet and allow for user interaction" and "software installed...to allow interface with the Internet."

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C. Protestor asserts that the Protestor made public use and offered for sale, for more than one year prior to the date of the original application for patent upon which the present reissue application is based, the subject matter taught and claimed in the original patent and reissue application as demonstrated by the documents attached hereto.

Exhibits C, D, E, F, and G demonstrate that the Protestor made public use and offered for sale the subject matter claimed in the original patent (claims 1-5 of the present reissue application) and are applied against claims 1-4 under 35 USC 103 and in combination with U.S. Pat. No. 4,359,631 to Lockwood et al. against claim 5 under 35 USC 103 as set forth below. However, it is not clear from the documents presented that the Protestor made public use and offered for sale the subject matter of claims 6-9 in the reissue application, namely, the “means for accessing the Internet and allow for user interaction” and “software installed...to allow interface with the Internet.” Although Exhibit C,4 shows a frame from the video tape of Exhibit C advertising connection to the Internet, it was stated in the deposition of Daniel J. Toughey (Exhibit K, page 44, lines 10-23) that the terminal shown in the video tape did not actually enable a user to gain access to the Internet, but merely showed a possibility. The offering for sale of a mere conception of the invention before the critical date is not enough (note MPEP 2133.03(c), section I, A). The Protestor fails to show that the invention was developed beyond mere conception.

3. Protest filed April 1, 1999 under 37 CFR 1.291(a) by North Communications, Inc.

A. Protestor asserts that claims 1-9 are anticipated by the prior art (Exhibits A2, A6, M).

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Exhibits A2 and A6 are directed to a government kiosk system which receives payment from the user for the purchase of ordered products (e.g., items from the Government Printing Office, stamps-by-mail, EE Bonds; A2, page 37, section (d) and A6, page B36, section (d)) or the payment of fines or filing fees (e.g., motor vehicle registration, traffic fines, tax payment, naturalization request filing fee; A2, page 38, first paragraph and A6, pages B36 through B37). Exhibits A2 and A6 fail to anticipate claims 1-9 because they do not teach receiving payment from the kiosk user for “use of the terminal” (claim 1, lines 26-27; claim 5, lines 17-20; claim 6, lines 8-9). Moreover, since the purpose of the government kiosk system of Exhibits A2 and A6 is to provide electronic access to government information to all the public, guarding “against the risk of creating two societies: the electronic information ‘haves’ and ‘have nots’ (Exhibit A5, page 1), it would defeat this public service goal if a kiosk user were charged for using the terminal. The user is required to pay only for items that normally require payment, such as stamps, traffic fines, and document ordering. The user is not charged for “use of the terminal.”

Exhibit M discusses the components and design of a typical kiosk system. Although it discloses a credit card reader and communication with a credit authorization network (page 12, section 5.1.2; page 22, section 6.1), it does not teach receiving the credit card payment for using the terminal. As with Exhibits A2 and A6, Exhibit M discusses credit card payment for a purchased product, such as an airplane ticket (page 2, section 1.2.3), not for “use of the terminal.”

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B. Protestor asserts that claims 1-9 are obvious in view of the prior art (Exhibits B and K; B and I; B and L; I with any of C, D, E, F, G, H, or J).

Exhibit B (see Fig. 1) discloses an electronic mail system (10) in which electronic mail messages can be stored or retrieved through standard Automatic Teller Machines (ATMs 22, 24), point-of-sale (POS) terminals (34), or ATM/POS terminals (26, 28) by paying users. However, these terminals do not contain a telephone access node or an internal modem. Rather, they are connected to the existing ATM data communication network (16) and POS data communication network (38) which interconnect with regional and national clearinghouse networks for communicating transaction data. The purpose of the system in Exhibit B is to provide readily accessible public electronic mail communication using standard ATM/POS terminals by linking existing ATM/POS communication systems with an electronic mail system (col. 1, line 50 - col. 2, line 23). Exhibits K, I and L discuss the use of special-purpose information kiosks, not standard ATM/POS terminals which are already interconnected via existing ATM/POS data networks. Exhibit B specifically teaches away from the use of special purpose terminals and promotes the greater functionality of combining the existing ATM/POS networks with an electronic mail system (col. 1, lines 50-57) such that it would not have been obvious to an artisan of ordinary skill at the time of invention to incorporate an internal modem and telephone access node into each ATM/POS terminal to provide the online service.

Exhibits C, D, E, F, G, H, and J are articles describing various special-purpose kiosks for purchasing products or payment of fines, and Exhibit I teaches the desirability of Internet access

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and charging users for access and services. The examiner finds the exhibits relevant to the claimed invention but lacking in sufficient detail as to be applied against the claims in the manner suggested by the protestor. For instance, none of the exhibits specify an internal modem and a telephone access node within the terminal.

C. Protestor asserts that claims 1-5 are anticipated by the TouchFax product as disclosed in the exhibits submitted in the TouchNet Protest filed November 4, 1998. A rejection of claims 1-4 under 35 USC 103 as being unpatentable over the TouchFax product is set forth below, and a rejection of claim 5 under 35 USC 103 as being unpatentable over U.S. Pat. No. 4,359,631 (Lockwood et al.) in view of the TouchFax product.

D. Protestor asserts that new claims 6-9 added in the reissue application are prohibited by 35 USC 251 because they contain new matter, namely, connection to the Internet.

A rejection of claims 6-9 under 35 USC 251 for containing new matter, namely, connection to the Internet, is set forth below.

Claims 6-9 recite additional subject matter which is not supported by the original disclosure, namely, a "housing" as containing the elements of claims 6-9; the "touch screen interface" of claim 7, lines 1-2; the "touch screen means" of claim 7, line 2; the "durable enclosure" of claim 9, line 1; and the "secured access door" of claim 9, line 2. A rejection of claims 6-9 under 35 USC 112, 1st paragraph is set forth below.

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E. Protestor asserts that the original patent claims carried forth in the reissue application are prohibited by the statute as new matter. A rejection of claims 1-5 under 35 USC 112, 1st paragraph is set forth below.

4. Protest filed August 17, 1999 under 37 CFR 1.291(a) by Griffes Consulting, SA.

A. Protestor asserts that claims 1-9 are anticipated by the prior art (Exhibits A and B).

Exhibits A and B describe a TouchFax product, a free-standing public communications kiosk. The TouchFax product was similarly described in exhibits submitted with the TouchNet Protest filed November 4, 1998. A rejection of claims 1-4 under 35 USC 103 as being unpatentable over the TouchFax product as described in Exhibits E and F of the TouchNet protest filed November 4, 1998 and a rejection of claim 5 under 35 USC 103 as being unpatentable over U.S. Pat. No. 4,359,631 (Lockwood et al.) in view of the TouchFax product are set forth below. Although Exhibit B submitted by Protestor describes ISDN connection, it does not specify software installed to allow interface with the Internet, as recited in claim 6. The Internet is an interconnected computer network which links many computers over communication lines and to which access is achieved via software installed in a computer. Although communication with the Internet can take place over ISDN as the communication medium, ISDN connection is not the same as "means for accessing the Internet and allow for user interaction," as recited in claim 6.

B. Protestor asserts that claims 1-9 are rendered obvious by the prior art (Exhibits C and D).

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Although Exhibits C and D appear relevant to the claims, they lack certain elements recited in the claims, such as a printer, a touch screen interface and Internet access. Claims 1-9 are rendered obvious by prior art submitted in the Protest submitted by TouchNet Information Systems, Inc. and the Protest submitted by North Communications, Inc. as set forth below.

5. The drawings are objected to because the original disclosure does not support the showing of the terminal housing as depicted in Figure 2, which was submitted as part of a substitute sheet of drawing during the prosecution of the original patent. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. Figure 2, as originally filed, showed a cubicle with a work area/desk top, privacy wall, chair/stool and a terminal device generally labeled as numeral 2. There is no support in the original disclosure for the terminal housing as incorporating the monitor, keyboard, credit card reader, printer and an access door in the manner depicted in the current Figure 2. Correction is required.

6. Claims 6-9 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

Claim 6, lines 10 and 11, "the Internet."

Claim 8, line 2, "the Internet."

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New matter, that is, matter not present in the patent sought to be reissued, is excluded from a reissue application (MPEP 1411.02).

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The recitations of a "housing" as containing the elements of claims 1-9; the "touch screen interface" of claim 2, line 2 and claim 7, lines 1-2; the "touch screen means" of claim 2, lines 3-4 and claim 7, line 2; the "durable enclosure" of claim 4, line 2 and claim 9, line 1; the "secured access door" of claim 4, line 3 and claim 9, line 2; and the steps of method claim 5 are not supported by the original disclosure as filed on January 23, 1995.

The above new matter was added as an amendment to the specification during the prosecution of the original patent. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: col. 2, lines 3-7; col. 2, line 53 - col. 3, line 3.

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Applicant is required to cancel the new matter in the reply to this Office action.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article entitled "TouchFax Provides the Ultimate in Place-Based Interactivity" (submitted as Exhibit E in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit E") in view of the TouchFax brochure entitled "Vision, Power, Versatility" (submitted as Exhibit F in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit F").

Exhibit E discloses a public on-line, pay-as-you-use communications terminal (TouchFax public terminal; Exhibit E, first page, fifth paragraph) comprising a housing (kiosk housing; Exhibit E, photograph on first page), wherein said housing contains:

a central processing unit (386 microprocessor; Exhibit E, second page, first column, third paragraph, line 3);

a telephone access node (data port; Exhibit E, second page, first column, third paragraph, line 3);

an internal modem (modem; Exhibit E, second page, first column, third paragraph, line 5 and second column, second paragraph, line 11);

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a video display monitor (touch-sensitive color video monitor; Exhibit E, second page, first column, first paragraph and lines 2-3 of the third paragraph);

a keyboard (full-size keyboard; Exhibit E, second page, first column, third paragraph, lines 4-5);

a credit card reader (Exhibit E, second page, first column, second paragraph, lines 4-6);
means for accessing commercial on-line services and allow for user interaction (via touchscreen and computer modem; Exhibit E, second page, second column, second paragraph);

a printer (high-volume laser printer; Exhibit E, second page, first column, third paragraph, line 4).

Exhibit E differs from claim 1 in that it does not explicitly recite software installed into the CPU to allow interaction with commercial on-line service providers and credit card centers. However, Exhibit F teaches the use of such software installed into the CPU of a TouchFax terminal to carry out its communications functions (Exhibit F, first page, second paragraph) such that it would have been obvious to an artisan of ordinary skill to use such installed software, as described in Exhibit F within the TouchFax terminal of Exhibit E to carry out its communications functions with the commercial on-line service providers and credit card centers.

Regarding claim 2, Exhibit E provides for a touch screen interface and touch screen means for accepting input information (Exhibit E, second page, first column, first and second paragraphs; second page, second column, second paragraph).

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Regarding claim 3, Exhibit E provides for printing a detailed receipt (Exhibit E, second page, first column, second paragraph) or any other document (Exhibit E, second page, second column, second paragraph, lines 9-13).

Regarding claim 4, Exhibit F provides for a durable enclosure (heavy-duty steel cabinet; Exhibit F, second page, left-hand column, "Ergonomically Designed Cabinet") and a secured access door (Exhibit F, second page, left-hand column, "Access Door").

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lockwood et al. (USPN 4,359,631, hereinafter "Lockwood") in view of the article entitled "TouchFax Provides the Ultimate in Place-Based Interactivity" (submitted as Exhibit E in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit E").

Lockwood discloses a method of using a public on-line, pay-as-you-use terminal (self-service terminal 1) to access commercial on-line services (e.g., flight schedules, reservations, ticket purchasing services) comprising the steps (note Figure 9) of:

swiping a credit card through a credit card reader (credit card reader 22; operation of terminal 1 is initiated by customer payment in which payment can be effected either by depositing coins or charging to a credit card account after validation, the approval being received by central processor 30; col. 3, lines 34-38; col. 6, lines 22-33; col. 7, lines 10-13);

in response to input from the user (via keyboard 20) who is responding to a selection of on-line services that are assessable and displayed on a monitor (menu of services is displayed on

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monitor 10; col. 7, lines 13-24) and based on interaction between said user and said main program, controlling switching means (audio communications system; col. 7, lines 47-49) to provide communication between a telephone access node (connection with telephone link; Fig. 8) and a modem (modem 38) with a commercial on-line service (remote site computer 42; col. 7, lines 41-51);

printing with a printer (printer 11) a hard copy of documents (col. 7, lines 51-58);

deactivating (user can select a return to the basic menu display after which the system returns to a standby status if no further selection is made within the next thirty seconds; col. 7, lines 59-62, 34-40).

Lockwood differs from claim 5 in that although it provides for accepting payment for services and includes a printer, it does not specify printing a billing statement. However, Exhibit E teaches the desirability of printing a billing receipt at a public terminal which accepts payment for services for the purpose of record keeping (TouchNet protest, Exhibit E, second page, first column, second paragraph) such that it would have been obvious to an artisan of ordinary skill to incorporate the printing of a billing statement, as taught by Exhibit E, within the method of Lockwood in order to provide the user with a hard copy record of transaction expenses.

12. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article entitled "TouchFax Provides the Ultimate in Place-Based Interactivity" (submitted as Exhibit E in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit E") in view of an article by

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Rawan Shah entitled "Suggestions for Information Kiosk Systems using the World Wide Web", submitted with the Protest by North Communications, Inc. as Exhibit I (hereinafter "the Shah article").

Exhibit E discloses a public on-line, pay-as-you-use communications terminal (TouchFax public terminal; Exhibit E, first page, fifth paragraph) comprising a housing (kiosk housing; Exhibit E, photograph on first page), wherein said housing contains:

a central processing unit (386 microprocessor; Exhibit E, second page, first column, third paragraph, line 3);

a telephone access node (data port; Exhibit E, second page, first column, third paragraph, line 3);

an internal modem (modem; Exhibit E, second page, first column, third paragraph, line 5 and second column, second paragraph, line 11);

a video display monitor (touch-sensitive color video monitor; Exhibit E, second page, first column, first paragraph and lines 2-3 of the third paragraph);

a keyboard (full-size keyboard; Exhibit E, second page, first column, third paragraph, lines 4-5);

a credit card reader (Exhibit E, second page, first column, second paragraph, lines 4-6);

means for accessing and allow for user interaction (via touchscreen and computer modem; Exhibit E, second page, second column, second paragraph);

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a printer (high-volume laser printer; Exhibit E, second page, first column, third paragraph, line 4).

Exhibit E differs from claim 6 in that it does not specify means for accessing and software for interfacing with the Internet. However, Exhibit E does allow for accessing and interfacing with a remote service provider via a modem and the Shah article teaches the desirability of providing access to and interaction with the Internet in a kiosk-based information system (pages 1-2, section entitled "The Effectiveness of the World Wide Web as Kiosk-based Information System") via the use of appropriate software (Web browser; page 2, section entitled "The Access Interface," line 2) to provide users with access to the many services on the Internet including a paid service by commercial organizations which charges customers for access to specific services (page 2, section entitled "Who will use these systems?" and page 5, lines 11-12). It would have been obvious to an artisan of ordinary skill to incorporate such means for accessing and software for interfacing with the Internet in a kiosk information system, as taught by the Shah article, within the kiosk information system of Exhibit E in order to provide users with access to the many services available on the Internet.

Regarding claim 7, Exhibit E provides for a touch screen interface and touch screen means for accepting input information (Exhibit E, second page, first column, first and second paragraphs; second page, second column, second paragraph).

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Regarding claim 8, Exhibit E provides for printing a detailed receipt (Exhibit E, second page, first column, second paragraph) or any other document retrieved from a remote source (Exhibit E, second page, second column, second paragraph, lines 9-13).

Regarding claim 9, Exhibit E provides for a durable enclosure and a secured access door (Exhibit E, photo of housing with front access panel on first page).

13. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 305-9508, (for informal or draft communications, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella Woo whose telephone number is (703) 305-4395 and can normally be reached Monday - Friday, 6:30 a.m. until 11:30 a.m.

August 24, 1999



**STELLA WOO
PRIMARY EXAMINER**